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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,353	07/27/2001	Francis Pruche	010830-119	6986

7590 03/25/2004

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EXAMINER	
JIANG, SHAOJIA A	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/915,353	PRUCHE ET AL.	
	Examiner	Art Unit	
	Shaojia A Jiang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-25,27-34 and 45-63* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-25,27-34 and 45-63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on December 12, 2003 wherein claims 31 and 58 have been amended.

Currently, claims 21-25, 27-34, and 45-63 are pending in this application.

Applicant's amendment filed on December 12, 2003 with respect to the rejection of claims 31 and 58 made under 35 U.S.C. 112 second paragraph for the use of the indefinite expressions, of record stated in the Office Action dated July 16, 2003 have been fully considered and found persuasive to remove the rejection since the indefinite expressions have been removed from the claims. Therefore, the said rejection is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-22, 24-25, 29-31, 45, 48-49, and 51-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Pruche et al. (FR 2787319, equivalent to US 6,409,772) for the same reasons of record in the previous Office Action July 16, 2003.

Pruche et al. (FR 2787319) discloses a method of applying a composition comprising the particular compound of formula (I), 4,5-dihydroxystilbene-3-O-beta-D

glucoside (the instant compound), a physiologically acceptable medium and additives to keratinous materials such as hair, see claims 4, 6, 20-21 and abstract in particular. The amount of the glucosylated stilbene (0.01-10%) reads on the effective amounts recited in the instant claims. Pruche et al. also discloses topically applying the composition therein to skin, e.g., dyeing the skin and dyeing hair.

Applicant's remarks filed on December 12, 2003 with respect to this rejection of claims made under 35 U.S.C. 102(b) of record stated in the Office Action have been fully considered but they are not deemed persuasive to render the claimed invention patentable over the prior art as further discussed below.

Applicant argues that "in view of the fact that the compositions are used for dyeing, it is not predictable whether the compositions, being essentially applied to the keratinous materials and not to the skin or the hair follicles, would be applied in an effective amount and for a sufficient period of time for obtaining the claimed results of the presently claimed method, e.g., for combating signs of aging of the hair follicles". Applicant also argues that the inherency may not be established by probabilities or possibilities.

Applicant's arguments are not found convincing. First, dyeing the hair reads on combating signs of aging of the hair follicles by changing the gray (the signs of aging) back to the original color of younger age. Second, Pruche et al. also discloses topically applying the composition therein to skin. Any properties exhibited by or benefits provided the use of composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if

the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently treat skin and hair as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an appliïation for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an intemational application by another who has fulfilled the requirements of pararaphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 21-25, 27-34, and 45, 48-60 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Pezzuto et al. (WO 01/30336) for the same reasons of record in the previous Office Action July 16, 2003.

Pezzuto et al. (WO 01/30336) discloses a method for treating or preventing skin conditions such as those associated with sun damage and natural aging comprising topically administering a composition comprising a topical carrier (emulsifiers, solubilizers, emollients, preservatives, water) and a prodrug of resveratrol auch as cis or trans resveratrol glucosides, see claims 1-10, 20-21 and 43 in particular. Pezutto et al teaches that resveratrol and its glucosides are art equivalents, see for example claims 5 and 8. Pezzuto et al. also teaches that compounds such as trans or cis-resveratrol, and trans or cis-resveratrol gludocoside have been known to protect low-density lipoproteins against oxidation (see page 1 lines 20-23). Thus, these compounds are known anti-oxidants to be applied to skin.

Applicant's remarks and Exhibits filed on December 12, 2003 with respect to this rejection of claims made under 35 U.S.C. 102(b) of record stated in the Office Action have been fully considered but they are not deemed persuasive to render the claimed invention patentable over the prior art as further discussed below.

It is noted that Applicant admits that cis-resveratrol glucoside and trans-resveratrol glucoside are particularly preferred by Pezzuto et al. (see page 11 therein). Hence, cis-resveratrol glucoside and trans-resveratrol glucoside, the instant compounds, are particularly preferred by Pezzuto et al. in treating a method for treating or preventing skin conditions such as those associated with sun damage and natural

aging. Applicant also argues that Pezzuto et al. do not indicate why these compounds are preferred. Applicant's argument is not convincing. The answer to why or mechanism of action of cis-resveratrol glucoside and trans-resveratrol glucoside in/on the skin is not required to under 35 U.S.C. 102(b) to anticipate the instant claims. Moreover, Pezzuto's method steps are same as the instant method steps. See *Ex parte Novitski*, 26 USPQ 2d 1389. Moreover, the claiming of a new use, new function or unknown property which is inherently present in the prior art does not make the claim patentable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 21-25, 27-34, and 45-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carson et al. (WO 99/04747 of record), Pezzuto et al. (WO 01/30336 of record), and Teguo (of record) for the same reasons of record in the previous Office Action July 16, 2003.

Carson et al. (WO 99/04747) teaches that resveratrol, a phytoestogen present in red grapes and wine, is useful in methods of inhibiting the proliferation of keratinocytes and stimulating their differentiation, improving the appearance of wrinkled, lined, dry, flaky, aged or photodamaged skin, improving skin thickness, elasticity, flexibility; radiance, glow and plumpness, see in particular abstract and claims 3-4. Carson et al.

(WO 99/04747) also teaches that cosmetic compositions containing grape extract are known in the art, see in particular page 4 lines 23-33. Pezutto et al teaches that resveratrol and its glucosides are art equivants, i.e., conditions that are responsive to resveratrol are also responsive to its glucpsides, see for example claims 1-10.

Teguo teaches that E and Z piceid, E-astringen and E-Z resveratroloside are found in Vitis vinifera and Polygunum cuspidamm root, see page 655.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ grape extract in Carson et al.'s methdds of trzating and/or improving skin conditions.

One of ordinary skill in the art would have been motivated to employ grape extract in Carson et al.'s methods of treating and improving skin becausq grape extract is known to contain both resveratrol and piceid (3,4,5-trihydroxystilbene-3-beta-mono-D-glucoside), known to be useful in cosmetic compositions. Furthermore the prior art teaches that glucosylâted resveratrol is also known to be employed in topical composition used in skin treating compositions.

Applicant's remarks and Exhibits filed on December 12, 2003 with respect to this rejection of claims made under 35 U.S.C. 103(a) of record in the previous Office Action have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art.

Applicant asserts that the presently claimed invention also possesses surprising and unexpected results which confirms its nonobviousness; that is, the presently claimed invention discloses unexpected results and advantages for the use of

glycosylated hydroxystilbene. Contrary to Applicant's assertion, the results of glycosylated hydroxystilbene in the composition to apply to skin in the method of treatment herein have been anticipated, taught and suggested by the cited prior art herein. Therefore, the results herein are clearly expected and not unexpected based on the cited prior art. Moreover, expected beneficial results are evidence of obviousness. See MPEP § 716.02(c).

In view of the rejections to the pending claims set forth above, no claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. Anna Jiang, Ph.D.
Patent Examiner, AU 1617
March 10, 2004